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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,985	01/04/2002	Steven N. Verona	VEROX 101	7751
7590	09/09/2004		EXAMINER	
Jason H. Foster Kremblas, Foster, Phillips & Pollick 7632 Slate Ridge Blvd. Reynoldsburg, OH 43068			FOSTER, ROLAND G	
			ART UNIT	PAPER NUMBER
			2645	

DATE MAILED: 09/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/037,985	VERONA, STEVEN N.	
	Examiner Roland G. Foster	Art Unit 2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 04 January 2002.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-29 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-29 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date: _____
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date: <u>X 3</u>	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 8-17, 18, 20, 23, 25, and 27-29 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,507,643 B1 to Groner (hereinafter "Groner").

With respect to claim 1, the caller dials a telephone number for connecting to a central computer (Fig. 1, calling telephone 32 and "voice to electronic" mail system 30, Fig. 11A, step 242). The "voice to electronic" mail system 30 (central computer) compares an intended recipient identifier (called telephone number) with data corresponding to a plurality of subscribers in a subscriber database (recipients e-mail addresses) in order to retrieve the correct e-mail address (Fig. 9 and col. 7, line 66 – col. 8, line 18).¹ The caller can also input a communication code, such as the caller's telephone number (Fig. 11C, step 282).² Groner clearly discloses that the "voice to electronic" mail system 30 (central computer) then constructs an e-mail message addressed to the electronic address of the intended recipient containing information corresponding to the communication code (calling party telephone number). The e-mail is

¹ Interpreting a "intended recipient identifier" as a specific instance of the dialed telephone number is consistent with the applicant's claim structure (e.g., see claim 8).

transmitted via packet-based network 42, which in one embodiment is the Internet (col. 4, lines 44-48).

With respect to claims 8 and 9, see the claim 1 rejection for further details.

With respect to claim 10, the dialed telephone number comprises alphanumeric.

With respect to claim 11, see Fig. 11C, step 286.

With respect to claims 12-14 and 16-18, the IVR dialogue manager 104 accepts both verbal and touch tone responses (col. 11, lines 43-67).

With respect to claim 15, the calling telephone number would comprise pressing a plurality of touchtone buttons. See the claim 1 rejection for further details.

With respect to claim 20, see the claim 1 rejection for further details.

With respect to claim 23, the e-mail address corresponds to the text display device, which is based is a computer and which is personal in nature (Fig. 1).

With respect to claim 25, see col. 7, lines 41-51.

² Interpreting a "communication code" as the caller's telephone number is consistent with the applicant's claim

With respect to claim 27, see Fig. 11D.

With respect to claim 28, reception of an e-mail with an voice attachment would notify the intended recipient of the recorded voice message (Fig. 7).

With respect to claim 29, see col. 4, lines 20-30.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-7 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Groner as applied to claim 1 above, and further in view of U.S. Patent No. 6,385,306 B1 to Baxter, Jr. (hereinafter "Baxter").

With respect to claim 2, although Groner teaches that the caller may enter the recipient identifier directly, Groner fails to disclose that this identifier is compared with data identifying a plurality of subscribers (col. 16, lines 20-30).

However, Baxter (similarly to Groner) teaches of a system for allowing a telephone caller to generate an e-mail (abstract and Fig. 6), where the caller may enter the identifier directly (e.g., a "speed-dial" previously entered email address) that is compared to an address book (compared with data identifying a plurality of subscribers) (Fig. 6, step 240).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to add the caller inputting the intended recipient identifier that is compared with data as taught by the telephonic e-mail system of Baxter to the process of inputting the intended recipient identifier as disclosed by the telephonic e-mail system of Groner.

The suggestion/motivation for doing so would have been to allow speed dialing codes, which increase the efficiency and user-friendliness of recipient identification by avoiding the need for the "caller...to repeatedly enter in the same email addresses" via a limited capability DTMF interface (Baxter, col. 3, lines 14-23) and to "make the retrieval of the preselected email address as simple as possible (Baxter, col. 6, liens 32-40).

With respect to claims 3 and 5, see the claim 1 rejection for further details.

With respect to claim 4, see Groner, col. 11, lines 60-67.

With respect to claim 26, see the claim 2 rejection for further details for addition of subscriber's address book facility, where the user modifies electronic (e-mail) addresses stored in the address book. Further, "Official Notice" is taken that both the concept and advantage of allowing the user to access this address book for modification purposes via the Internet would have been well known and expected in the art.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to make modification of electronic addresses in the address book disclosed by Groner in view of Baxter available via the Internet.

The suggestion/motivation for doing so would have been to increase the accessibility of user data by providing that data via the Internet, which would have been notoriously well known in the art.

With respect to claim 6 and 7, the IVR dialogue manager 104 accepts both verbal and touch tone responses (Groner, col. 11, lines 43-67).

Claims 19, 21, 22, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Groner as applied to claims 1, 18, 20 above.

Although Groner discloses sending the e-mail to a text display device (Fig. 1), Groner fails to disclose that this text display device processes instant messaging and web mail and whether the device is a PDA or wireless.

However, "Official Notice" is taken that both the concept and advantages of a personal text display devices processing instant messaging and web mail in the form of PDAs and wireless devices would have been well known and expected in the art.

Therefore, it would have been obvious to add to the text display device disclosed by Groner the processing of instant messaging and web mail in the form of a PDA and wireless device.

The suggestion/motivation for doing so would have been to increase the accessibility and reach of e-mail devices by supporting web mail and instant messaging and to support typical e-mail devices such as PDAs and wireless pagers and phones as is notoriously well known in the art.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roland Foster whose telephone number is (703) 305-1491. The examiner can normally be reached on Monday through Friday from 9:00 a.m. to 5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan S. Tsang, can be reached on (703) 305-4895. The fax phone number for this group is (703) 872-9309.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to customer service whose telephone number is (703) 306-0377.



Roland G. Foster
Primary Patent Examiner
August 23, 2004